UNITED STATES PATENT AND TRADEMARK OFFICE

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09/783,073	02/15/2001	Yoshinori Ito	35.C15126	3810

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EXAMINER
HEWITT II, CALVIN L

ART UNIT	PAPER NUMBER
3621	

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Please find below and/or attached an Office communication concerning this application or proceeding.

PTO-90C (Rev. 10/03)

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on <u>28 March 2006</u>.

2a)☒ This action is **FINAL**.   2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) <u>1-6,8,13,14,16 and 33-44</u> is/are pending in the application.

     4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) <u>1-6, 8, 13, 14, 16 and 33-44</u> is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

     a)☐ All   b)☐ Some *   c)☐ None of:

       1.☐ Certified copies of the priority documents have been received.

       2.☐ Certified copies of the priority documents have been received in Application No. _____.

       3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

     * See the attached detailed Office action for a list of the certified copies not received.

Status of Claims

1.   Claims 1-6, 8, 13, 14, 16 and 33-44 have been examined.

Response to Amendments/Arguments

2.   Applicant is of the opinion that the prior art does not teach discriminating whether or not an input image is a predetermined image. The Examiner respectfully disagrees. According to Holmes et al., a security message (figure 2) is only applied to a document if and only if the document is protected by a license (column 5, lines 25-45). Hence, if a user computer attempts to open, or otherwise process, a document for which there is no license, the user social security number, for example, will not be attached to the document. Therefore, Holmes et al. specifically teach discriminating between license protected documents (i.e. predetermined image) and non-license protected documents. Regarding "banknotes", Holmes et al. apply their licensing system to documents, picture, graphic, video, audio and computer data, in general (column 6, lines 35-43). Therefore, if a user has stored computer data on the user's computer wherein the data comprises an image of a banknote (figure 2), the licensing system of Holmes et al. will determine if it is license protected data (i.e. predetermined

image) and apply a security message if the data is to be viewed or printed

(column/line 5/65-6/3). The Examiner maintains the rejection.

The following assertion of facts by the Examiner has gone unchallenged

and are now considered admitted prior art:

- pay for goods and services using a debit card

- computers that control output based on paper size or color.

As an aside, the Examiner is curious how Applicant's system prevents

illegal copying of a banknote (Applicant's Specification, page/lien 47/18-48/7).

Claim Rejections - 35 USC § 103

3.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for

all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

4.   Claims 1, 3-7, 14, 16, and 33-44 are rejected under 35 U.S.C. 103(a) as

being unpatentable over Holmes et al., U.S. Patent No. 6,119,108 in view of

Srinivasan, U.S. Patent No. 6,460,076.

As per claims 1, 3, 5, 7, 14, 16, and 33-37, Holmes et al. teach an image

processing apparatus comprising:

- first input means for entering predetermined information on an addressee of fee billing from said information communication apparatus (column 5, lines 25-32)

- second input means for entering an image (column 4, lines 58-64)

- addition means for adding said information on the addressee of fee billing to said image in a manner not easily recognizable to human eyes and outputting said image (column 6, lines 51-59)

- information such as information that specifies credit card company and credit card user (column 5, lines 25-32)

- first input means for entering information for enabling activation (column 5, lines 60-66) and second input means also for enabling activation in response to the entering of enabling information (abstract)

- discrimination means for discriminating whether said image is a specified image and control means for controlling the addition by said addition means based on the result of discrimination by discrimination means (column 5, lines 25-58)

- inquiry means for authenticating predetermined information by communicating through a communication channel with an external server (column 5, lines 32-44)

Regarding "adding means" or more generally the process for adding information

to an entered image, this is taught by Holmes et al. as a user does not see, for

example, the computational process by which bits of an image are changed so

that payment information (column 5, lines 25-31) is added to the image. The user

only becomes aware of the computer's actions (e.g. adding means) after the fact

such as when the user attempts to access protected content (figure 2). Holmes et

al. inherently or at least suggests a computer interface or GUI for entering

predetermined information (e.g. credit card number) (column 5, lines 25-28).

Hence, Holmes et al. also teach memory means for storing the predetermined

information and inquiry means for sending the information to an external device

(e.g. cybercash, credit card, EFT, SET or other remote clearinghouse computer).

Regarding the predetermined information, Holmes et al. require a user to re-enter

the information in order to access the protected content (column 6, lines 4-11).

Therefore, it is inherent to Holmes et al. or at least Holmes et al. clearly suggest

the deletion of the entered payment information. Otherwise, system security

and/or user payment information is comprised (column 5, lines

25-28; column 6, lines 4-11 and 51-59). Holmes et al., however, does not

specifically recite when the information is deleted. Srinivasan teaches a secure

method for processing data by deleting information from memory after it has

been used (column 5, lines 45-60; column 6, lines 14-42). Therefore, it would

have been obvious to one of ordinary skill to the delete payment information of

Holmes et al. after it has been used (e.g. entered into an image) in order to save

memory ('076, column 5, lines 45-50) or maintain a secure system by preventing

the payment information of previous users to be displayed to new users ('108,

column 5, lines 25-31; column 6, lines 51-60).

As per claim 4, Holmes et al. teach a first input means for entering

credit card information on an addressee of fee billing from said information

communication apparatus (column 5, lines 25-32). Holmes et al. do not teach

debit card information. However, it is well known to those of ordinary skill in

electronic commerce to pay for goods and services using a debit card, therefore,

it would have been obvious to allow content consumers to pay for content using a

debit card (figure 2).

As per claim 6, Holmes et al. teach outputting content using a computer

(figure 2). Computers that control output based on paper size or color are old and

well known.

5.   Claim 2 is rejected under 35 U.S.C. 103(a) as being unpatentable over

Holmes et al., U.S. Patent No. 6,119,108 and Srinivasan, U.S. Patent No.

6,460,076 in view of May, U.S. Patent No. 6,021,492.

As per claim 2, Holmes et al. teach a system for protecting content using a

communication apparatus (i.e. plug-in embodied in a computer) that controls the

use of software on a user computer (column 5, lines 15-53). Srinivasan teaches a

secure method for processing data by deleting information from memory after it

has been used (column 5, lines 45-60; column 6, lines 14-42). However, neither

Holmes et al. nor Srinivasan specifically recite outputting information to the

communication apparatus based on an outputted image. May teaches content

protection by limiting the number of access a user has to content (figures 11-14).

Specifically, May teaches outputting information to a content control module

based on outputted content (figures 10-15; column/line 9/58-11/67). Therefore, it

would have been obvious to one of ordinary skill to combine the teachings of

Holmes et al., Srinivasan, and May in order to allow content creators to allow

users to try content before purchasing and to provide users with other

compensatible methods for accessing content other than buying ('492,

column/line 9/58-11/52).

6.   Claims 8 rejected under 35 U.S.C. 103(a) as being unpatentable over

Holmes et al., U.S. Patent No. 6,119,108 and Srinivasan, U.S. Patent No.

6,460,076 as applied to claim 1 above, and in further view of, Chou et al., U.S.

Patent No. 5,337,357.

As per claim 8, Holmes et al. teach a first input means for entering

information from said information communication apparatus (column 5, lines 25-

32). Srinivasan teaches a secure method for processing data by deleting

information from memory after it has been used (column 5, lines 45-60; column

6, lines 14-42). However, neither Holmes et al. nor Srinivasan specifically recite

entering apparatus information. Chou et al. teach a method for protecting content

using input information such as an apparatus identifier (abstract; figure 1).

Therefore, it would have been obvious to one of ordinary skill to combine the

teachings of Holmes et al.. Srinivasan and Chou et al. in order to use personal

information such as user computer-specific information to protect content ('108,

column 5, lines 29-31; '357, figure 1).

7.   Claim 13 is rejected under 35 U.S.C. 103(a) as being unpatentable over

Holmes et al., U.S. Patent No. 6,119,108 in view of Krishnan et al., U.S. Patent

No. 6,073,124 and Srinivasan, U.S. Patent No. 6,460,076.

As per claim 13, Holmes et al. teach an image processing apparatus

comprising:

- first input means for entering information on an addressee of fee

  billing from said information communication apparatus (column 5,

  lines 25-32)

- second input means for entering an image (column 4, lines 58-64)

- addition means for adding said information on the addressee of fee

  billing to said image in a manner not easily recognizable to human

  eyes and outputting said image (column 6, lines 51-59)

Regarding "adding means" or more generally the process for adding information

to an entered image, this is taught by Holmes et al. as a user does not see, for

example, the computational process by which bits of an image are changed so

that payment information (column 5, lines 25-31) is added to the image. The user

only becomes aware of the computer's actions (e.g. adding means) after the fact

such as when the user attempts to access protected content (figure 2). Holmes et

al. inherently or at least suggests a computer interface or GUI for entering

payment information (column 5, lines 25-28). Similarly, Holmes et al. require a

user to re-enter the information in order to access the protected content (column

6, lines 4-11). Therefore, it is inherent to Holmes et al. or at least Holmes et al.

clearly suggest the deletion of the entered payment information. Otherwise,

system security and/or user payment information is comprised (column 5, lines

25-28; column 6, lines 4-11 and 51-59). However, Holmes et al. do not

specifically recite a first input means for entering information on an addressee of

fee billing (e.g. credit card information specifying a company and a user) and a

password. Krishnan et al. teach an information communication apparatus

comprising:

- a third input means for entering information on an addressee of fee billing

  (e.g. credit card information specifying a company and a user) and a

  password (figures 14 and 15)

- third output means for outputting said information to an external server (figures 3 and 12; column 19, lines 45-60; column/line 20/64-21/2)

- fourth output means for outputting to an image processing apparatus information on the address of fee billing according to a result of identification on said information on the addressee of fee billing and said password in said external server (figure 12; column 19, lines 63-67)

- fourth input means for entering information and fifth output means for outputting information to said external server (figure 17)

However, neither Holmes et al. nor Krishnan et al. specifically recite when the information is deleted. Srinivasan teaches a secure method for processing data by deleting information from memory after it has been used (column 5, lines 45-60; column 6, lines 14-42). Therefore, it would have been obvious to one of ordinary skill to modify the teachings of Holmes et al., with the authentication method of Krishnan et al. and the payment information processing of Srinivasan in order protect buyers and sellers from fraud ('108, column 5, lines 25-31 and 34-44; column 6, lines 51-60; '124, figures 12-17, column 19, lines 20-67).

Conclusion

8.   **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire

THREE MONTHS from the mailing date of this action. In the event a first reply is

filed within TWO MONTHS of the mailing date of this final action and the advisory

action is not mailed until after the end of the THREE-MONTH shortened statutory

period, then the shortened statutory period will expire on the date the advisory

action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be

calculated from the mailing date of the advisory action. In no event, however, will

the statutory period for reply expire later than SIX MONTHS from the mailing

date of this final action.

9.   Any inquiry concerning this communication or earlier communications from

the Examiner should be directed to Calvin Loyd Hewitt II whose telephone

number is (571) 272-6709. The Examiner can normally be reached on Monday-

Friday from 8:30 AM-5:00 PM.

If attempts to reach the Examiner by telephone are unsuccessful, the

Examiner's supervisor, James P. Trammell, can be reached at (571) 272-6712.

Any response to this action should be mailed to:

Commissioner of Patents and Trademarks

c/o Technology Center 3600

Washington, D.C. 20231

or faxed to:

(571) 273-8300 (for formal communications intended for entry and

after-final communications),

or:

(571) 273-6709 (for informal or draft communications, please label

"PROPOSED" or "DRAFT")

Information regarding the status of an application may be obtained from

the Patent Application Information Retrieval (PAIR) system. Status information

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direct.uspto.gov**. Should you have questions on access to the Private PAIR

system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-

free).

Calvin Loyd Hewitt II
Primary Examiner

May 15, 2006